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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,675	02/24/2000	TAKESHI OGINO	015358/0104	9758

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EXAMINER	
WACHTEL, ALEXIS A	

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/485,675	OGINO ET AL.
	Examiner	Art Unit
	Alexis Wachtel	1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Detailed Action

Response to Amendment

1. Applicant's amendment and accompanying Remarks filed 8-4-2003 have been entered and carefully considered. The Declaration filed 12-16-2003 has also been considered.

The amendment is sufficient to overcome the obviousness rejections of claims 16-35 and the 112 2nd paragraph rejections of claims 17-21,23,28 and 31 by way of the present amendment. Claims 16-35 are cancelled without prejudice. Claims 36-55 were added for consideration.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 36-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB2000440A in view of JP 06294006A.

In reference to claim 36-55, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a

different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The Examiner is of the opinion that the structure resulting from the combination of GB 2000440A and JP 06294006A is exactly the same as the product by process of the instant Application. The prior art to JP 06294006A did not reveal any extraordinary difficulty that might be encountered when combining "N-38 Toyobo Co., Ltd" fibers with another fiber. As a results it is fair to assume that combining "N-38 Toyobo Co., Ltd" fibers with another fiber type used in clothing insulation could be successfully carried out through conventional blending methodology.

GB 2000440A discloses a filler for quilts, pillows, cushions, sleeping bags, ski jackets wherein said filler is composed of feathers and fibers (pp.1, col 1, lines 5-9). Said filler consists of substantially homogenous mixture of feathers and fibers comprising from 01.% to 40% by weight of fibers of said mixture and from 99.9% to 60% by weight of feathers by blending means whereby a substantially homogenous distribution of fibers among feathers is produced. Examiner note: GB20000440A does not mention the use of a binder in the blending process. Said fibers are preferably made of polyacrylonitrile and are sized at 1 to 40 mm in (Abstract).

GB2000440A as set forth above fails to teach the use of moisture absorbing heat releasing fibers. JP 06240064A is directed to insulation used in clothing such as skiwear (pp.1, [002], lines 1-4) and teaches that it is known to use heat releasing moisture absorbing fibers such as "N-38 Toyobo Co., Ltd" (pp.1, [0015], lines 12-15) for their ability to generate heat on contacting moisture, thus making articles such as skiwear much more comfortable (pp.3 and 4, [0022], lines 1-4, [0023], lines 1-5, [0024], lines 1-

12_. In view of this teaching, it would have been obvious for one of ordinary skill in the art to have substituted a heat releasing moisture absorbing fiber such as "N-38 Toyobo Co., Ltd" for the polyacrylonitrile fiber used by GB2000440A motivated by the desire to obtain a superior outerwear insulation comfortable to a user.

Since Applicant clearly states using "N-38 Toyobo Co., Ltd" as the heat releasing moisture absorbing fibers it is reasonable to assume that all of the method limitations associated with the production of said fibers are inherently provided by virtue of "N-38 Toyobo Co., Ltd" being Applicant's desired fibers. Absent evidence to the contrary, the "N-38 Toyobo Co., Ltd" fibers discussed by the Applicant are assumed to be identical to the "N-38 Toyobo Co., Ltd" fibers disclosed by JP 06240064A.

Since Applicant makes specific exemplary use of "N-38 Toyobo Co., Ltd" fibers the claimed chemically manipulative steps are presumed as having been carried out in creating "N-38 Toyobo Co., Ltd" fibers. Should Applicant contest this assertion, alternate and chemically dissimilar manipulative steps must be provided as evidence.

Examiner Comments

4. The Applicant has provided a Declaration that sets forth a biased opinion that is purely speculative in nature and makes several factually deficient allegations. For example, it is alleged that "all established manufacturing processes fail to blend and disperse the moisture absorbent/releasable heat generating fiber in the second fiber homogenously. The resulting blend is lumpy and performs poorly as a garment material (Section 7, Declaration provided 12-13-2003). The Examiner notes that the Applicant discusses that unexpected results have been obtained through the use of the claimed

process. These unexpected results are presumably the structural charecteristics of the claimed product by process. However, the Applicant has not provided any evidence to support this allegation in the form of a qualitative or quantitative comparison to the disclosure of the prior art. Additionally, once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi,* 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann,* 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

Fortunately, the Examiner also notes that Applicant has alleged that "factories usually handle such fiber in a humidified atmosphere to avoid generating static electricity. Applicants surprisingly found that they had to abandon regular processes and use either very low humidity or very high (saturated) humidity prior to blending to achieve a stable blending ratio" as described on page 3 line 18 of the Specification. To accelerate prosecution, the Examiner believes that an evidenciary submission showing that a humid environment is usually used to handle such a fiber, whereby "such a fiber" is understood to be the claimed first and second fibers of the present invention would be extremely useful. Additionally, since the blended product produced by the method of the present invention is alleged to have a different structure as compared to the product

obtained through the use of the methods disclosed by the prior art, it would be even more useful to allow for a visual comparison of the claimed product by process to the product of the prior art that does not employ Applicant's manufacturing methodology. Clearly, if there are unexpected results associated with Applicant's product by process, the use of conventional manufacturing techniques in an attempt to duplicate Applicant's product should result with a structure that is substantially different from Applicant's product by process structure. The Examiner welcomes and appreciates any attempts by Applicant to accelerate prosecution.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alex Wachtel, whose number is (703)-306-0320. The Examiner can normally be reached Mondays-Fridays from 10:30am to 6:30pm.

If attempts to reach the Examiner by telephone are unsuccessful and the matter is urgent, the Examiner's supervisor, Mr. Glenn Caldarola can be reached at (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700